UNITED STATES PATENT AND TRADEMARK OFFICE

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10/612,456	07/02/2003	Yen-Fu Chen	AUS920030421US1	5390

35525　　　7590　　　07/16/2007		EXAMINER	
IBM CORP (YA)		KE, PENG	
C/O YEE & ASSOCIATES PC			
P.O. BOX 802333		ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 April 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 20-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 20-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

This action is responsive to communications: Amendment, filed on 4/27/06.

This action is final.

Claims 1-18 and 20-22 are pending in this application. Claims 1, 8, 15, and 22 are independent claims. In the Amendment, filed on 4/27/06, claims 1,7, 8, 15, 21 and 22 were amended and claim 19 is cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, 8-11, 14, 15-18, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Easter US Publication 2004/073868.

As per claim 1, Easter teaches a method in a data processing system for presenting input fields from a document, the method comprising:

Parsing the document to identify a selected indicator associated with a set of mandatory input fields in the document; (see Easter, paragraph 0124) and

Presenting only the set of mandatory input fields. (see Easter, paragraph 0124; Since each field's visibility is controlled, the users can set non-mandatory fields to invisible)

As per claim 2, Easter teaches the method of claim 1. Easter further teaches wherein the presenting step comprises display the set of mandatory input fields in a window. (see Easter; paragraph 0085; Figure 27)

As per claim 3, Easter teaches the method of claim 1. Easter further teaches wherein the presenting step comprises:

Reformatting the document to contain only the set of mandatory input fields. (see Easter, paragraph 0124; Since each field's visibility is controlled, the users can set non-mandatory fields to invisible)

As per claim 4, Easter teaches the method of claim 1. Easter further teaches wherein the presenting step comprises:

Presenting a first input field from the set of mandatory input fields; (see Easter; paragraph 0043) and

Responsive to information being entered in the first input field, presenting a second input field from the set of mandatory input fields. (see Easter; paragraph 0043; the event, which second field becomes required or optional instead of read-only, is presenting a second input)

As per claim 7, Easter teaches the method of claim 1. Easter further teaches the method comprising:

Determining whether any of the set of mandatory input fields correspond to pre-stored information; (see Easter; paragraph 0038); and

Responsive to an input field within the set of mandatory input fields corresponding to pre-stored information, filling the input field within the set of mandatory input fields with the

pre-stored information. (see Easter; paragraph 0038; Automatic population of items is filling the input field)

As per claims 8-11 and 14; 15-18 and 21; they are rejected with same rationale as claim 1-4 and 7. Supra.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 6, 12, 13, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easter US Publication 2004/073868 in view of Philippe; US Patent 6,882,981

As per claim 5, Easter teaches the method of claim 1. However, Easter fails to teach the indicator is a hypertext markup language tag.

Philippe teaches the indicator is a hypertext markup language tag. (see Philippe; column 5, lines 20-40)

It would have been obvious to an artisan at the time of the invention to include Philippe's teaching with method of Easter in order to allow users to fill out the application over the internet.

As per claim 6, Easter and Philippe teach the method of claim 5. Philippe further teaches the document is a web page. (see Philippe; column 5, lines 20-40)

As per claims 12 and 13, and 20; they are rejected with the same rationale as claim 5 and 6. Supra.

As per claim 22, it is of the same scope as claim 5. Supra.

Response to Argument

Applicant's arguments filed on 4/26/07 have been fully considered but they are not persuasive.

Applicant's argument focused on the following:

A) Easter fails to teach "parsing the document to identify a selected indicator associated with a set of mandatory input field."

B) Philippe fails to teach the indicator is a hypertext markup language tag.

C) There is no motivation to combine Philippe with Easter.

Examiner disagrees.

A) The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In this case, Easter teaches this limitation because it analyzes and breaks down the document based on user's specification. (see Easter paragraph 0124) Parsing has been defined by Webster dictionary as analyzing and breaking down. In Easter, an user defines which fields are required, optional, visible, invisible... (see Easter paragraph 00124) By setting these requirements the user is actually analyzing the document and breaking down the components of the document. After user has established the setting for the document, the system analyses and breakdowns the document as directed by the user. (see Easter paragraph 0042-45) Therefore the system also parses the document based on the rule set by the user.

B) Philippe teaches this limitation because it parses through webpage form (see Philippe; column 8, lines 4-10) based on the identifiers on the forms, which include identifier for URL, identifier for form name, and identifier for relationship. (see Philippe; column 7, lines 55-70) These identifiers are hypertext markup language tag.

C) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Philippe provides a motivation, which is to improve users' online browsing experience when they have to fill out an online form. (see Philippe, column 2, lines 35-40; column 2, lines 65-70)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The

examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peng Ke

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